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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,033	02/20/2004	Arnold Finestone	82017-3699	1736

28765 7590 05/18/2005

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EXAMINER

JACKSON, MONIQUE R

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 05/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/784,033

Applicant(s)

FINESTONE ET AL.

Examiner

Monique R Jackson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 4, 11-16, 18-20 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Adelman (USPN 6,115,999.) Adelman teaches a method of forming a gift wrap article by providing a wrapping material with an inner surface having a cohesive coating while the outer surface has a layer of gift wrap decorative design (Abstract.) The article is placed on a portion of the inner surface and the wrapping material is applied over the article so that the article is between and completely surrounded by two layers of wrapping material which are squeezed together to form a closed package (Abstract.) The wrapping material may be used as a single sheet wrapped around the article or as two separate sheets pressed together (Col. 1, lines 39-45.) Adelman teaches that the wrapping material may comprise a closed-cell foam, which provides cushioning and waterproofness (*hence water-impermeable*), laminated to kraft paper wherein the cohesive surfaces only adhere to themselves (Col. 2, lines 1-7; Paragraph 2 of “Detailed Description”).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Finestone et al (USPN 5,244,702) in view of Adelman or Lutz or Krampe et al or Lovell. Finestone et al teach a paper-plastic laminate sheeting capable of being converted by conventional equipment into envelopes and other container products that initially are in a flat state and are normally made of paper (Abstract.). The sheeting is composed of a paper facing sheet cold-laminated to a reinforcing film of synthetic plastic material having the same dimensions by means of a water-based adhesive (Abstract; Figure 1; Claims.) The reinforcing film (*water-impermeable film*) is preferably polypropylene, polyethylene, nylon or polyester; is oriented, uniaxially or biaxially, to impart exceptional tear and burst strength characteristics to the waterproof product; and is subjected to a surface treatment to increase its dynes and its affinity to adhesives, wherein it is obvious to one skilled in the art that corona discharge treatment is a conventional surface treatment process to increase the dynes and affinity of a plastic film surface (Abstract; Col. 3, lines 9-14.) The sheeting includes a printable paper facing sheet whose gauge, weight and quality are appropriate to the end use for which the sheeting is intended and may be Kraft paper or coated paper, wherein considering the term "printable" it would have been obvious to one skilled in the art to provide a printed surface on the "printable paper facing" sheet(s) (Col. 2, line 66-Col. 3, line 8.) In some applications a three-ply sheet may be desirable wherein paper sheets are cold-laminated to both sides of the oriented plastic film, wherein when the three-ply laminate is being converted in standard equipment into an envelope or grocery bag in which the sheeting is slit and folded to form flaps or other elements which must be sealed together, it is possible to use conventional, commercially available adhesive rather than special adhesive (Col. 4, line 47-

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Col. 5, line 10.) Finestone further teaches an example wherein the sheeting is utilized to form an envelope with the flap of the envelope including an adhesive band of standard starch adhesive or a pressure sensitive adhesive.

5. Though Finestone et al teach that the waterproof paper-plastic laminate can be utilized to form an envelope or other container products, it does not specifically teach the packaging as instantly claimed wherein a cohesive material is applied to one entire surface of the packaging material which encloses and seals an article by contacting the cohesive material. However, Lutz teaches that a paper-plastic packaging material can be provided with a cohesive coating adjacent an article such that the cohesive coating may be on a single sheet of the packaging material that is folded about the article or on separate sheets of the packaging material that are pressed together such that the cohesive coatings are contacted to seal and enclose the article. Adelman also teaches a packaging process of wrapping an article in a paper-plastic laminate provided with a cohesive coating adjacent the article such that the cohesive coating may be on a single sheet of the packaging material that is folded about the article or on separate sheets of the packaging material that are pressed together such that the cohesive coatings are contacted to seal and enclose the article providing an automated method of wrapping an article in a package capable of functioning as a mailing unit. Additionally, Lovell teaches packaging an article by completely surrounding the article in a cohesive-coated material like paper or coated film to produce a packaged article suitable for transport (Abstract.) Further, Krampe et al teach a cold seal package wherein two substrates, such as polyolefins, papers, or composites thereof, can be sealingly engaged by a cohesive material applied to the entire surface of the substrate(s) or just a portion to form a package that completely surrounds an object such that the two substrates can be

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easily peeled apart without substantial damage to the substrates. Hence, one having ordinary skill in the art at the time of the invention would have been motivated to apply a cohesive material to an entire surface of either side of the packaging composite material taught by Finestone et al as taught by Adelman or Lovell to provide a wrapped package capable of being mailed or transported or as taught by Lutz or Krampe et al to provide an easy opening package. Further, it would have been obvious to one having ordinary skill in the art at the time of the invention to determine which layer to utilize as the exterior of the packaging based on the desired end use and further to provide a metallized layer to improve the barrier properties or aesthetic properties of the paper-plastic laminate as is well known and conventional in the art. One having ordinary skill in the art at the time of the invention would also have been motivated to provide the packaging laminate taught by Finestone et al with a print layer, whether on the exterior surface, the interior surface, or between the paper and plastic layers and viewable from the plastic side, as is common and conventional in the packaging art, based on the desired marketing and decorative properties for a particular end use. With respect to instant claim 6, though Finestone et al do not teach corrugating or fluting the paper-plastic laminate, it is well established in the prior art that a paper laminate packaging material may be corrugated to provide added protection to the packaged article as evident by Lutz et al or Lovell.

6. Claims 1-13, 15-19 and 21-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lovell in view of Finestone et al. Lovell teaches a method of forming a sealed package by folding a cohesive coated material like paper or coated film about a three-dimensional article to be packaged such that the coated paper or film contacts and adheres to itself surrounding the article but not adhered to the article being wrapped or packaged wherein multiplied packages

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may be produced and wherein the paper may be corrugated paper (Abstract; Col. 1, lines 6- 20; Claims.) Though Lovell teaches that the packaging material to be coated on its surface with cohesive material may be paper, corrugated paper, film or multiplied, Lovell does not teach the packaging laminate as instantly claimed. However, Finestone et al teach a paper-plastic laminate sheeting capable of being converted by conventional equipment into envelopes and other container products that initially are in a flat state and are normally made of paper which has exceptional properties. The sheeting is composed of a paper facing sheet cold-laminated to a reinforcing film of synthetic plastic material having the same dimensions by means of a water-based adhesive (Abstract; Figure 1; Claims.) The reinforcing film (*water-impermeable film*) is preferably polypropylene, polyethylene, nylon or polyester; is oriented, uniaxially or biaxially, to impart exceptional tear and burst strength characteristics to the waterproof product; and is subjected to a surface treatment to increase its dynes and its affinity to adhesives, wherein it is obvious to one skilled in the art that corona discharge treatment is a conventional surface treatment process to increase the dynes and affinity of a plastic film surface (Abstract; Col. 3, lines 9-14.) The sheeting includes a printable paper facing sheet whose gauge, weight and quality are appropriate to the end use for which the sheeting is intended and may be Kraft paper or coated paper wherein considering the term "printable" it would have been obvious to one skilled in the art to provide a printed surface on the "printable paper facing" sheet(s) (Col. 2, line 66-Col. 3, line 8.) In some applications a three-ply sheet may be desirable wherein paper sheets are cold-laminated to both sides of the oriented plastic film, wherein when the three-ply laminate is being converted in standard equipment into an envelope or grocery bag in which the sheeting is slit and folded to form flaps or other elements which must be sealed together, it is possible to

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use conventional, commercially available adhesive rather than special adhesive (Col. 4, line 47-Col. 5, line 10.) Therefore, one having ordinary skill in the art at the time of the invention would have been motivated to utilize the composite laminate taught by Finestone et al as the substrate material to be coated with cohesive material in the invention taught by Lovell given that Finestone et al teach that the composite laminate provides improved properties over other packaging materials; wherein it would have been obvious to determine which layer to utilize as the exterior of the packaging based on the desired end use as taught by Finestone et al and further to provide a metallized layer to improve the barrier properties or aesthetic properties of the paper-plastic laminate as is well known and conventional in the art. Lastly, one having ordinary skill in the art at the time of the invention would have been motivated to provide the packaging laminate with a print layer, whether on the exterior surface, the interior surface, or between the paper and plastic layers and viewable from the plastic side, as is common and conventional in the packaging art, based on the desired marketing and decorative properties for a particular end use.

7. Claims 14 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lovell in view of Finestone et al and in further view of Lutz or Adelman. The teachings of Lovell in view of Finestone et al are discussed above. Though Lovell teach that a single cohesive-coated sheet is folded about an article to produce the sealed package, it would have been obvious to one having ordinary skill in the art to utilize two separate coated sheets provided above and below the article to be packaged to produce the sealed package considering Lutz and Adelman, as discussed above, both teach two separate coated sheets can be utilized in an equivalent manner to a single folded sheet in producing a sealed package from cohesive-coated packaging material.

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Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-25 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6,706,388. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one having ordinary skill in the art at the time of the invention to combine dependent claim limitations and because corona discharge treatment is an obvious surface treatment to increase the surface dynes and render the surface receptive to adhesive. Further corrugation or fluting of a paper packaging laminate is conventional in the packaging art to provide improved protection to the packaged article and would have been obvious to one skilled in the art at the time of the invention.

10. Claims 1-25 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,699,541. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one having ordinary skill in the art at the time of the invention to combine dependent claim limitations. Though the patented claims are directed to the package

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forming material and the package only, the instant packaging process would have been obvious considering the nominal process steps of the instant claims are clearly disclosed in the product claims of the patented case. Further corrugation or fluting of a paper packaging laminate is conventional in the packaging art to provide improved protection to the packaged article and would have been obvious to one skilled in the art at the time of the invention.

11. Claims 1-25 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6,652,984 in view of Adelman or Lutz or Krampe et al or Lovell. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one having ordinary skill in the art at the time of the invention to combine dependent claim limitations wherein the reinforcing polymer film is a water-impermeable sheet and wherein corrugation or fluting of a paper packaging laminate is conventional in the packaging art to provide improved protection to the packaged article and would have been obvious to one skilled in the art at the time of the invention. Further, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide a cohesive coating on the flexible laminate as taught by Adelman or Lutz or Krampe or Lovell in order to provide a packaging material that may be easily wrapped about an article to produce a sealed package.

12. Claims 1-25 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-28 of U.S. Patent No. 6,797,395 in view of Adelman or Lutz or Krampe et al or Lovell. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one having ordinary skill in the art at the time of the invention to combine dependent claim

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limitations wherein the reinforcing polymer film is a water-impermeable sheet and wherein corrugation or fluting of a paper packaging laminate is conventional in the packaging art to provide improved protection to the packaged article and would have been obvious to one skilled in the art at the time of the invention. Further, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide a cohesive coating on the flexible laminate as taught by Adelman or Lutz or Krampe or Lovell in order to provide a packaging material that may be easily wrapped about an article to produce a sealed package.

13. Claims 1-25 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of copending Application No. 10/800,255. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one having ordinary skill in the art at the time of the invention to combine dependent claim limitations and the claims of the copending application fully encompass the claims of the instant invention with the exception of instant claim 6. However, with regards to instant claim 6, as previously recited, corrugation or fluting of a paper packaging laminate is conventional in the packaging art to provide improved protection to the packaged article and would have been obvious to one skilled in the art at the time of the invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monique R Jackson whose telephone number is 571-272-1508. The examiner can normally be reached on Mondays-Thursdays, 8:00AM-4:30PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on 571-272-1284. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Monique R. Jackson
Primary Examiner
Technology Center 1700
May 13, 2005